UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,536	09/22/2003	Tetsuro Motoyama	241505US CIP	5927

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EXAMINER
CHANKONG, DOHM

ART UNIT	PAPER NUMBER
2152	

NOTIFICATION DATE	DELIVERY MODE
03/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)
	10/665,536	MOTOYAMA, TETSURO
	Examiner	**Art Unit**
	DOHM CHANKONG	2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 December 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,21-25,29 and 30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,21-25,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *10/29/07, 12/10/07, 1/14/08, 2/15/08*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1>   This action is in response to Applicant's amendment, filed 12.19.2007. Claims 12-20 and

26-28 are canceled. Claims 1, 11, 21-23, and 25 are amended. Claims 29 and 30 are added. Claims

1-11, 21-25, 29, and 30 are presented for further examination.

2>   This is a final rejection.

Response to Arguments

3>   The independent claims have been amended to recite several new limitations.

Applicant argues that Fan fails to teach these new limitations. In particular, Applicant asserts

that Fan fails to disclose the new step of "processing the first device information and stored

information <u>of at least one other device monitored by the first monitoring device</u> to generate

second device information" (emphasis in original). Applicant's arguments are not persuasive

because the argument relies on language not in the claims.

The independent claims recite "processing the first device information and stored

information <u>of the device monitored by the first monitoring device</u> to generate second device

information" (emphasis added). One of ordinary skill in the art would not have necessarily

interpreted the "device" in the underlined portion as referring to "at least one other device

monitored by the first monitoring device" as argued by Applicant. Instead, based on the

other limitations in the claims, one of ordinary skill in the art would have reasonably

interpreted the limitation as referring only to the first device that is being monitored.

For instance, the claims recite "storing...the obtained first device information." Additionally, the claim recites processing "stored information of <u>the</u> device" (emphasis added). The use of "the" rather than "a" suggests that the term is referring to the previously claimed device rather than any other new devices. Based on this indicators, one of ordinary skill in the art would not have interpreted the limitation in a manner as argued by Applicant. Instead, one of ordinary skill would have interpreted the limitation as referring simply to any stored information about the first device only.

Furthermore, the claim recites storing the obtained first device information. It would have been reasonable to interpret "stored information" as the obtained first device information since that is the only "information" that is recited as being stored at the first monitoring computer. And based on these interpretations of Applicant's independent claims, Fan discloses the claimed limitations [see the rejections that follow]. Applicant should amend the claims to more clearly define what is intended to be Applicant's invention.

4>   Applicant also argues that Fan fails to disclose the limitations recited in claim 4 which require transmitting the second device information periodically regardless of a content of the second device information. Applicant asserts that his amended limitation overcomes Fan because Fan discloses transmitting second device information when a printer resource is below a particular threshold. However, the claim language does not capture the difference as asserted by Applicant.

The claim recites periodically transmitting information regardless of the content of the information. Fan also discloses transmitting information that allows the administrator to

monitor the devices; the notifications may be pushed [column 5 «lines 3-5»] to inform the administrator of "deficient printer resource levels, printer hardware problems, and changes in printer status" [column 6 «lines 4-8»]. Fan's transmission of information is not predicated on the content of the message itself but on the notification profile established by the administrator [column 5 «lines 45-49»]. Fan teaches that the information is periodically transmitted regardless of what content is within the notification.

Information Disclosure Statement

5>   The IDSs filed on 10.29.2007, 12.10.2007, 1.14.2008, and 2.15.2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Terminal Disclaimer

6>   The terminal disclaimer filed on 12.19.2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,714,971 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7> Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 4 recites periodically transmitting information regardless of the content of the information. Examiner was unable to find support for this functionality in Applicant's specification. If there is an objection to this rejection, Applicant should cite where in the specification that the functionality is described.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8> Claims 1-22, 25, 26, 29 and 30 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan et al, U.S Patent No. 6.310.692 ["Fan"].

9> As to claim 1, Fan discloses a method of monitoring a device communicatively coupled to a network, comprising:

obtaining, by a first monitoring computer using a first Internet protocol, first device information of the device, the first device information including (1) status information

obtained from sensors of the device, and (2) a device identification of the device [Figure 3 «items 250, 248» where : Fan's server reads on claimed first monitoring computer and Fan's printer reads on claimed first device | column 4 «line 63» to column 5 «line 14». Fan does not expressly disclose that the printer has sensors but this function is implied by the fact that the printer provides resource information to the first computer. Fan also does not expressly disclose that the device ID is included in the device information but this feature is implied by the fact that the notification must inform the administrator of the printer whose status he is receiving];

storing, by the first monitoring computer, the obtained first device information [column 5 «lines 15-18»];

processing the first device information and stored information of the device monitored by the first monitoring device to generate second device information that includes the first device information and the stored information [column 5 «lines 45-59» where the notification includes both the first device information collected from the printer as well as stored information such as the email addresses of the administrator or end users who are to receive the notification];

transmitting the second device information using a second Internet protocol from the first monitoring computer to a second computer [Figures 10-12 | column 4 «lines 11-14» : transmitting the notification to the client computer | column 5 «lines 45-59» : email or paging];

receiving said second device information by the second computer [column 5 «lines 45-59»],

wherein the first monitoring computer is remote from the device, and the first monitoring computer is the first computer to obtain the first device information from the device [Figure 3 «items 248, 250»].

10> As to claim 2, Fan discloses the first Internet protocol and the second Internet protocol are a same Internet protocol [column 4 «lines 4-8 and 59-62»].

11> As to claim 3, Fan discloses the first Internet protocol and the second Internet protocol are different Internet protocols [Figures 10-12 | column 4 «lines 4-8» where the second internet protocol take the form of http messages to the end user].

does disclose that the device sends messages to the first computer [column 5 «lines 3-11»] but Fan does not expressly disclose the message comprises an Internet electronic mail message. Sending emails containing status information from a monitored device to a monitoring device is well known in the art. Fan describes a pushing based method of sending messages whereby the printer initiates the process of sending status information to a supervising computer [column 5 «lines 3-14»].

It would have been obvious to one of ordinary skill in the art to have implemented email into Fan because email is a well known push-based messaging system. Email functionality has several benefits including the ability submit usage information when no response is required from the receiving party.

12>   As to claim 4, Fan discloses the transmitting step comprises transmitting the second device information to the second computer periodically regardless of a content of the second device information [column 5 «lines 3-14»].

13>   As to claim 5, Fan discloses the second device information comprises an Internet electronic mail message [column 4 «lines 59-62»]. Fan does not expressly disclose the message comprises an Internet electronic mail message. However, Fan does disclose that the device sends messages to the first computer [column 5 «lines 3-11»] but Fan does not expressly disclose the message comprises an Internet electronic mail message. Sending emails containing status information from a monitored device to a monitoring device is well known in the art. Fan describes a pushing based method of sending messages whereby the printer initiates the process of sending status information to a supervising computer [column 5 «lines 3-14»]. It would have been obvious to one of ordinary skill in the art to have implemented email into Fan because email is a well known push-based messaging system. Email functionality has several benefits including the ability submit usage information when no response is required from the receiving party.

14>   As to claim 6, Fan discloses:

generating, by the first monitoring computer, the second device information to include summary information regarding usage of the device [column 4 «lines 20-29 and 51-59»];

wherein the step of transmitting the second device information from the first monitoring computer comprises transmitting, by the first monitoring computer, the second device information that includes the information regarding usage of the device to the second computer [column 4 «lines 20-29 and 51-59»].

15>   As to claim 7, Fan discloses the network device is one of a printer, a copier, and a facsimile machine [Figure 3 «item 250»].

16>   As to claims 8-10, Fan discloses the obtaining step comprises obtaining the first device information over a network [column 4 «lines 2-4»]. Fan does not expressly disclose a the network as a WAN, an Intranet or a LAN. However, each of these networks are well known in the art as an example of a network that is taught in Fan. It would have been obvious to one of ordinary skill in the art to implement Fan's network as WAN for the well known benefits that such a network provides. For example, Intranets are well known networks implemented in corporate environments. LANs are well known for their ease of implementation. One would have been motivated for these reasons to implement Fan's network as a WAN, an Intranet, or a LAN for these reasons.

17>   As to claim 11, as it does not teach or further define over previously claimed limitations, it is similarly rejected for at least the same reasons set forth for claim 1.

18>   As to claim 21, Fan discloses a method of monitoring a plurality of devices communicatively coupled to a local network, comprising:

accessing, using a first internet protocol, the plurality of devices by a service center computer that is remote from said local network to obtain first device information of the plurality of devices, including information obtained from sensors of the plurality of devices [column 5 «lines 1-26» : pulling based model];

storing the obtained first device information [column 5 «lines 15-18»];

periodically processing the first device information and stored information of the plurality of devices monitored by the service center computer to generate a usage report for the plurality of devices that includes the first device information and the stored information [column 4 «lines 49-62» : notifications on resource usage | column 5 «lines 45-59» where the notification includes both the first device information collected from the printer as well as stored information such as the email addresses of the administrator or end users who are to receive the notification];

transmitting the usage report, using a second Internet protocol, from the service center computer to a second computer [column 4 «lines 49-62»]; and

receiving the usage report by the second computer [column 4 «lines 49-62» : notifications sent to end users].

19>   As to claim 22, Fan discloses transmitting the usage report from the service center computer to the second computer as an e-mail message, wherein said email message is transmitted at an application layer [column 4 «lines 59-62»].

20>   As to claim 25, as it does not teach or further define over previously claimed limitations, it is similarly rejected for at least the same reasons set forth for claim 21.

21>   As to claims 29 and 30, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 29 and 30.

22>   Claims 23 and 27 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan, in further view of Kolls, U.S Patent No. 6.601.040.

23>   As to claims 23 and 27, Fan does disclose transmitting data from the service center computer to the second computer but does not expressly disclose transmitting data as a facsimile message. Sending reports by fax is well known in the art.

For example, Kolls is directed towards are system for monitoring remote devices. Kolls expressly discloses that usage reports can be sent to administrators by fax [column 47 «lines 8-10»]. It would have been obvious to one of ordinary skill in the art to incorporate fax capability into Fan's system to increase the communications functionality of the system. Adding fax capability increases the number of options where a customer or staff can be notified of important information.

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24>   Claims 24 and 28 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan, in view of Danknick et al, U.S Patent No. 5.901.286 ["Danknick"].

25>   As to claims 24 and 28, Fan discloses receiving a request for transmission of the usage report from the second computer [column 1 «lines 33-36»]. Fan does not disclose translating the usage report into a format suitable for display on a web page.

Danknick discloses translating usage reports for printers into a format suitable for display on a web page [Figure 7 | column 4 «lines 50-60» | column 7 «lines 31-39»]. It would have been obvious to one of ordinary skill in the art to have modified Fan to include Danknick's web page functionality. One would have been so motivated in order to allow Fan's end users access to their printers through conventional technology like web browsers.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. C./
Primary Examiner, Art Unit 2152

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